

Attorney Docket: 4925-200RCE

Serial No.: **10/034,550**
Amdt. dated July 21, 2005
Reply to Office Action dated January 21, 2005

ARGUMENTS

The Office Action mailed January 21, 2005 has been reviewed and carefully considered. Claims 2-11, 16-17, 34-38, and 41-43 are presently pending, with Claims 34 and 41 being in independent form. No amendments are being made in this reply.

In the January 21, 2005 Office Action, the Examiner repeats the same rejections as were made in the May 5, 2004 Final Office Action. Namely, independent Claims 34 and 41, as well as Claims 2, 4-10, 16-17, 34-38, and 42-43 depending therefrom, were rejected under 35 USC §103(a) as obvious over Japanese App. Ser. No. 2000-176964 (hereinafter referred to as "the '964 application") in view of the schematic web page entitled "What is injection molding?" (hereinafter referred to as "the schematic web page") and Japanese Pat. Ser. No. 5050433 (hereinafter referred to as "the '433 patent"), and dependent Claim 3 was rejected under 35 USC §103(a) as obvious over the '964 application, the schematic web page, the '433 patent, and *Bompard* (U.S. Pat. No. 5,484,642; hereinafter referred to as "the '642 patent").

Our November 4, 2005 amendment made arguments and changes to the claims in order to overcome the May 5, 2004 Final Office Action rejections. In response to those amendments/arguments, the Examiner states that the amended claims are product-by-process claims, and thus that the new limitations added in the November 4, 2005 amendment, which recited steps taken during the process of making the product, have no effect in distinguishing over the prior art. In essence, the Examiner argues that, because the "claimed product appears to be the same or similar to that of the prior art, although produced by a different process", the claims are unpatentable.

As stated in §2113 **Product-by-Process Claims** of the Manual of Patent Examining Procedure (MPEP) for the U.S. Patent Office:

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to **impart distinctive structural characteristics** to the final product. See, e.g., *In re Garniero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such

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as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)".

Thus, the structure implied by the steps in a product-by-process claim should be considered when the step or steps impart distinctive structural characteristics. At least one step recited in both independent claims in the present application imparts distinctive structural characteristics.

Claim 34 recites a casing part having a reinforcing core material which "is preliminarily formed before the first and second resin surface layers are injection molded on the reinforcing core material." This step of preliminarily forming the reinforcing core material **imparts distinctive structural characteristics** to the product, namely, increased structural strength. See, e.g., lines 12-15 on page 5 ("By comprising a two-dimensional reinforcing core material it is possible to maintain strength even with small thicknesses, thus contributing to lighter weight and smaller size.").

Claim 41 recites a casing for a portable electronic device comprising a core preform of a predetermined shape, which is embedded between two resin surface layers which are injection molded onto opposite sides of the core preform. The step(s) of injection molding the two sides of the core, thereby embedding it between the two resin layers, **imparts distinctive structural characteristics** to the product, namely, strengthening the structural integrity of the casing.

Furthermore, Claim 41 recites that the core preform is impregnated with thermoplastic resin before the resin surface layers are injected molded onto it. This step of impregnating before injection molding **imparts distinctive structural characteristics** to the product, namely, integrating the surface layer and the core perform, thereby providing a firm bond.

Further still, Claim 41 recites a resin-made structural member extending from the first resin surface layer, where the resin-made structural member is formed by the same step of injection molding which formed the first resin surface layer. This step(s) of forming structural members extending from a resin surface layer in the same mold as the resin surface layer and at the same time **imparts distinctive structural characteristics** to the product, namely, the integration of the structural member with the resin layer from which it extends, and, in turn, the greater integration and bonding of the structural member with the core perform under the resin layer.

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At least because independent Claims 34 and 41 recite steps which impart distinctive structural characteristics to the product claimed therein, the structure implied by those steps should be considered when assessing the patentability of Claims 34 and 41. Furthermore, because that implied structure shows an unobvious difference between the claimed product and the prior art product (i.e., the increased structural strength, etc., described above), independent Claims 34 and 41 are patentable over the prior art product. See, e.g., *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). Accordingly, withdrawal of the rejection of Claims 31 and 41 is respectfully requested. At least through their dependence on independent Claims 34 and 41, dependent Claims 2-10, 16-18, 35-38, and 42-43 are also believed to be patentable over the cited prior art. Withdrawal of their rejection is also respectfully requested.

Based at least on the foregoing, allowance of all presently pending claims is respectfully requested.

Respectfully submitted,

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